

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/713,994  
In re application of: KEDDIE, James, *et al.*  
Filed: 16 November, 2000  
Art Unit: 1638  
Examiner: KRUSE, David H.  
Docket No. MBI-0022  
Customer No. 23678

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Mail Stop Petition  
Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

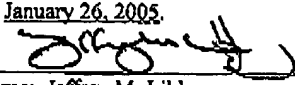
**Clarification of Response to Notice of Abandonment, filed with Petition for Revival of an  
Application for Patent Abandoned Unavoidably under 37 CFR 1.137(a)**

Dear Sir:

Pursuant to the Response mailed on October 4, 2004 (attached) to the Notice of Abandonment and for the purpose of complete disclosure and accuracy, Applicants would like to correct one statement made in the Response. With respect to all of the Office communications associated with the instant application, it is true that all of these communications were forwarded by the USPTO to the former representatives of Applicants. Regarding the statement made with respect to the Office letter of 10 June, 2003, on page 4, second paragraph of the Response: "[t]he latter and other documents were not forwarded to Applicants *or their latest representatives*" (*emphasis added*), in fact, a copy of this Office letter has since been found in the file at Morrison & Foerster, Applicants' present representatives. However, transmittal of this Office letter to Morrison & Foerster by Wiley, Rein & Fielding was significantly delayed, and, as told to Applicants, the Office letter was received past the period given in the Office letter in which to respond, at which point Applicants' present representatives filed the Office letter as they deemed no further action could or should be taken.

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to  
(703) 872-9306 at the United States Patent and Trademark Office  
on January 26, 2005.

  
Name: Jeffrey M. Libby

App. No. 09/713,994  
Correspondence dated January 26, 2005  
Clarification of Response to Notice of Abandonment

Other than the one correction noted above, Applicants believe all of the other statements in the Reponse and the Petition remain correct, including the facts that the USPTO mailed the communications leading up to abandonment, and the aforementioned Office letter, to the wrong address (that of the former representative, Wiley, Rein & Fielding in Washington, DC, rather than Applicants' present representatives, Morrison & Foerster in San Francisco, CA), and that Applicants never received this Office letter and thus could not respond within the time period noted in the Office letter. In fact, Applicants only obtained the 10 June, 2003 Office letter and the Notice of Abandonment though PARE, well after they were each mailed to the wrong address. What also remains true is that Applicants did indeed fully respond to the Examiner's telephonic request for canceling withdrawn claims and providing a copy of the CD-ROM filed with the application (now lost twice by the USPTO, the second time being a primary reason for abandonment), but were unaware of an additional request for a statement concerning the sequence listing, said hard-copy request having been mailed to the wrong address.

Should the USPTO find that the holding of unavoidable abandonment is not sustained by the facts presented herein and in the records for this application, Applicants request that the application be considered unintentionally abandoned, and authorize the USPTO to charge such fee to Mendel Biotechnology, Inc. Deposit Account No. 50-1025.

Respectfully submitted,  
MENDEL BIOTECHNOLOGY, INC.

Date: January 26, 2005

By: 

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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Applicant : : KEDDIE, James et al.  
Filing Date: : November 16, 2000  
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**Response to Notice of Abandonment, filed with Petition for Revival of an  
Application for Patent Abandoned Unavoidably under 37 CFR 1.137(a)**

Dear Sir:

In response to the Notice of Abandonment dated 13 April, 2004, Applicants submit the following arguments, and the requisite petition fee.

Errors made by the USPTO that contributed to this abandonment are summarized here and provided in greater detail below.

Summary

- The USPTO lost or misplaced original CD-ROMs containing Appendix A, which included sequences and trait descriptions.
- In a telephone conversation, the Examiner requested a replacement copy of Appendix A. The USPTO then lost or misplaced the replacement CD-ROM of Appendix A.
- The original Sequence Listing was filed in paper and computer readable format (CRF). A statement under 37 CFR 1.821-1.825 was provided stating that the content of both formats was the same. In a subsequent amendment, a polypeptide sequence that was predicted by SEQ ID NO: 15 in the Sequence Listing was added to a Substitute Sequence Listing. Thus,

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- the polypeptide sequence had been provided in paper and CRF formats, and it was stated that the two were the same. The amendment and a subsequent response noted that the polypeptide sequence had been filed with original Appendix A provided "in the original CD" (and thus was in a CRF).
- Shortly after the telephonic request for a replacement of Appendix A, an Office communication was mailed requesting a replacement copy of Appendix A, a CRF of the substitute Sequence Listing, and a statement that the the paper and electronic contents were the same. This Office letter was sent to the wrong address, that of a former attorney of record from whom authority had been revoked by Applicants. This Office letter never reached Applicants.
- When applicants allegedly failed to respond to the Office letter sent to the wrong address, and when applicants had in fact responded in kind in their amendments and two separate attempts to place a copy of Appendix A at the USPTO, the application was abandoned.

Detailed description of events leading up to abandonment

On 13 April, 2004, a Notice of Abandonment (Exhibit A) for application 09/713,994 was mailed for "failure to timely file a proper reply to the Office letter mailed on 10 June 2003" (Exhibit B, paper no. 18). Exhibits A and B were mailed to "Wiley Rein & Fielding, LLP". The Notice of Abandonment indicates that "[n]o reply was received". Applicants have recently obtained PAIR access, and have now been able to determine some of the miscues led to the abandonment of this application. In fact, Applicants did reply to each and every communication made to Applicants, and did respond to the Examiner's request for a copy of an Appendix that had been lost or misplaced by the USPTO. Applicants had also previously submitted a statement averring that the content of the paper and CRF Sequence Listings were the same. For these reasons, provided in greater detail below, Applicants believe this application was unavoidably abandoned.

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The Notice of Abandonment states that Applicants were not fully responsive to the earlier Office communication of 10 June, 2003 because: (a) an additional sequence was added to a Substitute Sequence Listing and no CRF or statement that the paper copy and the CRF were the same were included, and (b) CD-ROM copies of Appendix A were not in the file and new copies were necessary.

However, included with the instant application as filed were a paper copy of the Sequence Listing, a CRF of the Sequence Listing, and a statement that the content of the two was the same. The Sequence Listing contained 109 polynucleotide sequences. The Application also included Appendix A on two CD-ROMs. These were noted on the Utility Patent Application Transmittal (Exhibit C). Appendix A comprised a number of nucleotide and polypeptide sequences in CRF, including those sequences in the Sequence Listing, and experimental observations associated with plants expressing the polypeptides.

An Amendment and Substitute Sequence Listing were filed 30 December, 2002, which Applicants believed would help clarify claims to polypeptides. A 110<sup>th</sup> sequence was added to the Sequence Listing; no new matter was added by this amendment for reasons noted below.

As to the requirement in the Office letter of 10 June 2003 that a copy of Appendix A be submitted because the Appendix was not in the file wrapper, Applicants mailed a replacement Appendix A to the USPTO on two (2) separate occasions; both of said submissions were lost or misplaced by the USPTO. The first time Appendix A was submitted was with the application as filed, as noted on the Application Transmittal (Exhibit C). The second submission (Exhibit E) was in response to the Examiner's telephonic request (Exhibit F) made on March 31, 2003. Applicant's Exhibit E includes a statement that the replacement copy of Appendix A was identical to that originally filed with the instant application. Exhibit E also stated that "Appendix A as submitted with the instant application at the time of filing contained the polynucleotide and polypeptide sequences for SEQ ID NO: 110 (G896)". Statements 3 and 4 in Exhibit E noted that SEQ ID NO: 110 was also present in an earlier copending provisional application claimed as a priority application. Thus, SEQ ID NO: 110 was not new matter, as noted in Exhibit D, the amendment in which it was added, and Exhibit E. Attached to Exhibit E is a copy of a stamped, returned postcard indicating receipt by the USPTO of the CD containing the replacement copy of Appendix A, the Transmittal Form mailed with the replacement

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copy and Exhibit E showing "Submission of Courtesy Copy of Appendix A", and four pages printed from the CRF Appendix A showing the SEQ ID NO: 110 entry and polypeptide sequence.

In the telephone interview of 31 March, 2003, the Examiner also requested clarification of several of the claims of the instant application. Applicants promptly responded to all of the requests that were made in the interview by transmitting a clarification of the claims the very same day (the claims in question were canceled; see "Supplemental Amendment" attached to Exhibit F). Applicants responded within 15 days by preparing and mailing to the USPTO the replacement copy of Appendix A, after diligently confirming that the contents were the same as filed. The telephone interview made not reference to the sequence added to a Substitute Sequence Listing filed in a prior amendment, and the lack of a CRF or statement that the paper copy and the CRF were the same.

On 10 June, 2003, the USPTO mailed to Applicants the aforementioned Office letter once again requesting a copy of Appendix A, and noting the lack of a CRF or statement that the paper copy and the CRF were the same with the Amendment filed adding one sequence to the Sequence Listing. The request for a replacement Appendix A was the same request the Examiner had made two months prior, and to which Applicants had just replied. However, Applicants never received this mailing. Prior to this mailing on 5 August, 2002, Applicants filed a Revocation of Prior Power of Attorney and Power of Attorney, naming agents or attorneys at Morrison and Foerster, LLP, as well as Jeffrey M. Libby and Matthew Kaser of Mendel Biotechnology, Inc. Copies of this Revocation of Prior Power of Attorney and Power of Attorney, the transmittal and self-addressed, stamped return postcard showing receipt by the USPTO of these documents are attached (Exhibit G). However, Office communications associated with the instant application continued to be forwarded to the former representatives of Applicants, including the Office letter of 10 June, 2003. The latter and other documents were not forwarded to Applicants or their latest representatives. In fact, Applicants only obtained the 10 June, 2003 Office letter and the Notice of Abandonment though PARE, well after they were each mailed to the wrong address.

In spite of their not having received the Office letter of 10 June, 2003, Applicants had already responded to the Examiner's request with the replacement copy of Appendix A, and had submitted CRF and paper versions of the Sequence Listing, and had stated that these were the same in content. Applicants added SEQ ID NO: 110, that was not new matter, in a Substitute Sequence Listing. The

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amendment of Exhibit D and the later filed Exhibit E stated that SEQ ID NO: 110 added to the paper copy of the Sequence Listing was the same as the sequence filed as a CRF in originally filed Appendix A (and was thus the same in both paper format and CRF).

If the Examiner needed further clarification, this request never reached Applicants. Applicants were unaware of the Examiner's request to combine SEQ ID NO: 110 into a new Sequence Listing in CRF, since this communication was forwarded to the former attorney of record from whom authority to prosecute this application had been revoked. Had this request become known to Applicants, they would have responded as promptly as they had responded to the part of the request that was communicated to Applicants by telephone.

In conclusion, the instant application became abandoned for alleged failure to respond to two requests in an Office communication. However, two Office communications were made at approximately the same time (first by telephone, then by letter). Applicants did respond the former by resubmitting Appendix A, which again became lost at the USPTO, and were unaware of any other request by the Examiner because this was not communicated in the telephone interview and was not communicated to Applicants but to an attorney from whom authority had been revoked.

Applicants believe that as a result of these miscommunications, this application has been unavoidably abandoned.

Applicants have prepared yet another set (i.e., a third set) of copies of Appendix A in the form of two identical CD-ROMs, and will forward these to the appropriate Receiving Office pending action on this petition. Applicants have also prepared an electronic version of the Substitute Sequence Listing containing 110 sequences, including SEQ ID NO: 110, which will also be forwarded to the USPTO when appropriate.

For future reference, the contents of the CD-ROMs each containing the latest replacement of Appendix A is identical to the CD-ROMs containing Appendix A as originally filed. The contents of the CD-ROMs each containing the Substitute Sequence Listing in CRF is identical to the Sequence Listing as originally filed in both paper and computer readable format, except that SEQ ID NO: 110 is appended to the Sequence Listing as filed. No new matter is incorporated in these submissions.

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Respectfully submitted,

MENDEL BIOTECHNOLOGY, INC.

Date: October 4, 2004

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